

Application Number 09/820,398
Responsive to Office Action mailed November 16, 2005

REMARKS

This amendment is responsive to the Office Action dated November 16, 2005. Applicants have amended claims 1, 4, 6-9, 21, 25, 26, 28-30, and 33, and cancelled claims 2, 3, 31, and 32. Claims 1, 4, 6-30, and 33 are pending upon entry of this amendment, with claims 11-20 and 22-24 being withdrawn.

Claim Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-4, 6-10, 21 and 25-33 under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US 6,948,070). Applicants respectfully traverse the rejection to the extent such rejections may be considered applicable to the claims as amended. The applied references fail to disclose or suggest the inventions defined by Applicants' claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

The system of Ginter et al. fails to include the structure and constructs required by Applicants' claim 1. Applicants' claim 1 discloses *four* distinct network interfaces by which four distinct parties having specifically defined interrelationships may access a single data storage device.

For example, Ginter et al. fails to teach or suggest a system in which a franchisor uses a franchisor network interface to approve product information stored on a data storage device, and a franchisee uses a franchisee network interface to select and order a product based on the approved product information. Ginter et al. makes no mention of a franchisor approving product information, nor does Ginter et al. mention a franchisee selecting and ordering a product based on the approved product information. Moreover, Ginter et al. fails to disclose a third party network interface by which a third party manages access of the franchisee to the franchisor approved information, and permits the third party to communicate a product order to a manufacturer via the network. Ginter et al. also fails to disclose a manufacturer network interface by which the manufacturer can process the received product order in accordance with the approved product information.

In the Office Action, the Examiner acknowledged that these features of Applicants independent claims are not disclosed or suggested by Ginter et al. Nonetheless, the Examiner

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concluded that it would have been obvious to one of ordinary skill in the art to have labeled one of the multiple users as a sub-end-user because it is common knowledge in the art. Applicant respectfully disagrees with this conclusion.

To the contrary, Ginter et al. describes a conventional electronic transaction management system, in which a customer ("end user") may purchase online content from a content owner. There is no teaching or suggestion to provide access by a franchisor, a franchisee, a third party, and a manufacturer to a single data storage device to act in accordance with approved product information. Moreover, these terms are not mere "labels" for different users. Applicant's claims include many elements directed to the functional relationship of these parties and recite particular structural elements that allows those relationships to be achieved via a computing system. In contrast, Ginter et al. includes a summary of the roles of the various participants of its virtual distribution environment, (see col. 253, ln. 40–col. 254, ln. 12), but there is no reference whatsoever to franchisors, franchisees, or manufacturers. Further, Ginter does not describe a system having the features to support the functions required by Applicant's system. As one example, this summary of the roles of Ginter describes "end users" as "consumers of information." In contrast, the end user of claim 1 is a franchisor that approves product information.

Consequently, the invention defined by Applicants' claim 1 contains a number of features not taught or suggest by the system of Ginter et al., features that do not become obvious even when one of the end users is renamed as a "sub-end-user" or even a "franchisee." Ginter et al. fails to disclose or suggest a centralized data storage device, accessible by a franchisor, a franchisee, a third party, and a manufacturer using four distinct network interfaces in the manner recited by claim 1.

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection.¹ This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.² Deficiencies in the evidentiary record cannot be cured by general conclusions such as "general knowledge" or "common sense."³ Accordingly, the Examiner cannot rely on unsupported, conclusory

¹ *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

² *Id.*

³ *Id.*

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statements to close holes in the evidentiary record.⁴ Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant's dependent claims, the claims should be allowed. In this case, the Examiner has cited no references that teach or suggest many elements of Applicant's claims. Consequently, the Examiner has failed to provide substantial evidence required to establish a prima facie case of obviousness, and has failed to meet the evidentiary standard required to uphold such rejection.

Moreover, one of ordinary skill in the art in possession of Ginter et al. would have no motivation to modify Ginter et al. to result in Applicants' claimed invention. The Examiner asserted that "[t]he motivation for having provided such would have been using common known entities [sic] with the data delivery system of Ginter." The Examiner has failed to offer any teaching in Ginter et al. or any other prior art reference that would have suggested such motivation. One of ordinary skill in the art would not have been motivated based on Ginter et al. to include a franchisor network interface by which a franchisor can approve product information, or any other of the limitations of claim 1 discussed above. Further, as explained above, the data delivery system of Ginter et al. falls far short of the requirements of amended claim 1. Thus, even if one of ordinary skill in the art were motivated to modify Ginter et al. to include a sub-end-user, as asserted by the Examiner, this modification would not result in Applicants' invention as claimed.

The Court of Appeals for the Federal Circuit has made clear that motivation to combine references must be found in the prior art, and that it is impermissible hindsight for the Examiner to use the motivation stated in Applicant's own disclosure as a blueprint to reconstruct the claimed invention from the prior art.⁵

Claims 4, 6-10, 21, 25-30 and 33 depend from independent claim 1 and are allowable for at least the reasons set forth above. Moreover, dependent claims 4, 6-10, 21, 25-30 and 33 include a number of features not addressed by the Examiner, nor taught by Ginter et al.

⁴ *Id.*

⁵ See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

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To the extent the Examiner maintains the rejection in light of Applicants' amended claims, Applicants respectfully request the Examiner to clarify the relationship between the elements of Applicants' claims and Ginter et al.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 1, 4, 6-10, 21, 25-30 and 33 under 35 U.S.C. 103(a).

Withdrawal of this rejection is requested.

CONCLUSION

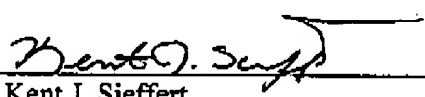
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

By:

February 15, 2006

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